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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,792	01/23/2001	Craig A. Lewis	07703-327001 / WCR0117	2248
26211	7590	05/05/2004	EXAMINER	
FISH & RICHARDSON P.C. 45 ROCKEFELLER PLAZA, SUITE 2800 NEW YORK, NY 10111			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,792

Applicant(s)

LEWIS ET AL.

Examiner

John L. Young

Art Unit

3622

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

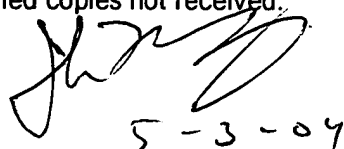
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

  
5-3-04

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-70 are rejected under 35 U.S.C. §103( a ) as being obvious over Tedesco et al. US 6,161,059 (12/12/2000) [US f/d: 09/14/1998] (herein referred to as "Tedesco").

As per independent claim 1, Tedesco (the ABSTRACT; FIG. 1; FIG. 2; FIG. 5; FIG. 6; FIG. 7; FIG. 8A; FIG. 8B; FIG. 9A; FIG. 9C; FIG. 10; col. 1, ll. 5-10; col. 2, ll. 12-50; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-12; and whole document) shows: "A method for providing discounts for items in an automatic transaction machine comprising: validating cash or card and a discount means having an associated discount value; detecting a selection of an item or a group or items, each having a preset vending price; and discounting the vending price of the item or group of items according to the discount value."

Tedesco lacks an explicit recitation of the wording of independent claim 1, even though the cited disclosure of Tedesco implicitly shows same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Tedesco would have been selected in accordance with the elements and limitations of claim 1, because selection of such features would have provided means for "*permitting customers to participate n a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.*" (See Tedesco (col. 2, ll. 20-27)). Furthermore, the instant invention would have been rendered obvious in view of Tedesco, because the claims of the instant invention suffer from undue breadth.

As per claims 2-24, Tedesco shows the method of claim 1 and subsequent base claims depending from claim 1.

Tedesco (the ABSTRACT; FIG. 1; FIG. 2; FIG. 5; FIG. 6; FIG. 7; FIG. 8A; FIG. 8B; FIG. 9A; FIG. 9C; FIG. 10; col. 1, ll. 5-10; col. 2, ll. 12-50; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-12; and whole document) shows the elements and limitations of claims 2-24.

Tedesco lacks an explicit recitation of the elements and limitations of claims 2-24 even though the disclosure of Tedesco implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Tedesco would have been selected in accordance with the elements and limitations of claims 2-24, because selection of such features would have provided means for *“permitting customers to participate in a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.”* (See Tedesco (col. 2, ll. 20-27)).

Independent claim 25 is rejected for substantially the same reasons as independent claim 1.

As per claims 26-48, Tedesco shows the article of claim 25 and subsequent base

claims depending from claim 25.

Tedesco (the ABSTRACT; FIG. 1; FIG. 2; FIG. 5; FIG. 6; FIG. 7; FIG. 8A; FIG. 8B; FIG. 9A; FIG. 9C; FIG. 10; col. 1, ll. 5-10; col. 2, ll. 12-50; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-12; and whole document) shows the elements and limitations of claims 26-48.

Tedesco lacks an explicit recitation of the elements and limitations of claims 26-48 even though the disclosure of Tedesco implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Tedesco would have been selected in accordance with the elements and limitations of claims 26-48, because selection of such features would have provided means for *“permitting customers to participate in a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.”* (See Tedesco (col. 2, ll. 20-27)).

Independent claim 49 is rejected for substantially the same reasons as independent claim 1.

As per claims 50-62, Tedesco shows the device of claim 50 and subsequent base claims depending from claim 50.

Tedesco (the ABSTRACT; FIG. 1; FIG. 2; FIG. 5; FIG. 6; FIG. 7; FIG. 8A; FIG. 8B; FIG. 9A; FIG. 9C; FIG. 10; col. 1, ll. 5-10; col. 2, ll. 12-50; col. 3, ll. 1-67; col. 4, ll.

1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-12; and whole document) shows the elements and limitations of claims 50-62.

Tedesco lacks an explicit recitation of the elements and limitations of claims 50-62 even though the disclosure of Tedesco implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Tedesco would have been selected in accordance with the elements and limitations of claims 50-62, because selection of such features would have provided means for *“permitting customers to participate n a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.”* (See Tedesco (col. 2, ll. 20-27)).

As per independent claim 63, Tedesco (the ABSTRACT; FIG. 1; FIG. 2; FIG. 5; FIG. 6; FIG. 7; FIG. 8A; FIG. 8B; FIG. 9A; FIG. 9C; FIG. 10; col. 1, ll. 5-10; col. 2, ll. 12-50; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-12; and whole document) shows the discount device of claim 63

Tedesco lacks an explicit recitation of the wording of independent claim 63, even though the cited disclosure of Tedesco implicitly shows same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Tedesco would have been selected in accordance with the elements and limitations of claim 63, because selection of such features would have

provided means for *“permitting customers to participate n a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.”* (See Tedesco (col. 2, ll. 20-27)). Furthermore, the instant invention would have been rendered obvious in view of Tedesco, because the claims of the instant invention suffer from undue breadth.

As per claims 64-70, Tedesco shows the device of claim 63 and subsequent base claims depending from claim 63.

Tedesco (the ABSTRACT; FIG. 1; FIG. 2; FIG. 5; FIG. 6; FIG. 7; FIG. 8A; FIG. 8B; FIG. 9A; FIG. 9C; FIG. 10; col. 1, ll. 5-10; col. 2, ll. 12-50; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-12; and whole document) shows the elements and limitations of claims 64-70.

Tedesco lacks an explicit recitation of the elements and limitations of claims 64-70 even though the disclosure of Tedesco implicitly shows same.

It would have been obvious to a person of ordinary skill in the art that the cited disclosure of Tedesco would have been selected in accordance with the elements and limitations of claims 64-70, because selection of such features would have provided means for *“permitting customers to participate n a marketing promotion while making a purchase at a vending machine, and to receive a reward for such participation.”* (See Tedesco (col. 2, ll. 20-27)).



### CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'John L. Young', with a stylized, sweeping flourish extending from the end of the signature.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

Primary Patent Examiner

May 3, 2004